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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,634	09/08/2003	Gary Bann	67176389.001400	3446
23562 7590 01/07/2009 BAKER & MCKENZIE LLP PATENT DEPARTMENT 2001 ROSS AVENUE SUITE 2300 DALLAS, TX 75201				
EXAMINER				
FRENEL, VANEL				
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3687				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/658,634

Applicant(s)

BANN, GARY

Examiner

VANEL FRENEL

Art Unit

3687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/31/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed on 10/31/08. Claims 1, 2, 11, 15, 17, 20, 22, 24, and 27 have been amended. Claims 1-28 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
3. Claims 1-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-28 recite a process comprising the steps of determining, determining, placing and placing. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horwitz et al. (6,496,806) in view of Francis et al. (6,600,418).

As per claim 1, Horwitz discloses a method for configuring a controlled area with RFID tags for tracking the location of items within the controlled area (See Horwitz, Col.1, lines 13-30), placing the plurality of RFID tags in accordance with the determined locations (See Horwitz Fig.5; Col.9, lines 11-32; Col.10, lines 16-35).

Horwitz does not explicitly disclose that the method comprising: determining a measurement accuracy for the location of the items; determining locations for a plurality of RFID tags based on the determined measurement accuracy; placing two RFID interrogators on a vehicle used to move items within the controlled area, the RFID interrogators each configured to read the plurality of RFID tags and separated by a separation distance for determining the location of the items.

However, these features are known in the art, as evidenced by Francis. In particular, Francis suggests that the method comprising: determining a measurement accuracy for the location of the items (See Francis, Col.9, lines 25-47); determining locations for a plurality of RFID tags based on the determined measurement accuracy

(See Francis, Col.9, lines 32-67); placing two RFID interrogators on a vehicle used to move items within the controlled area, the RFID interrogators each configured to read the plurality of RFID tags and separated by a separation distance for determining the location of the items (See Francis, Fig.5; Col.9, lines 25-67 to Col.10, line 16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Francis within the system of Horwitz with the motivation of providing a pass-through location, such a loading dock gate or a truck docked at the loading dock gate, is marked by an RFID assembly having two RFID tags spaced in close proximity to each other (See Francis, Col.3, lines 50-64).

As per claim 2, Francis discloses the method wherein determining locations comprises determining a spacing for each of the plurality of RFID tags (See Francis, Co1.3, lines 50-54).

As per claim 3, Francis discloses the method wherein the determined spacing is less than or equal to the determined measurement accuracy (See Francis, Co1.9, lines 33-46).

As per claim 4, Francis discloses the method wherein determining the locations further comprises locating each of the plurality of RFID tags in a grid based on the determined spacing (See Francis, Fig.4; Col.9, lines 33-46).

As per claim 5, Francis discloses the method wherein placing the plurality of RFID tags comprises assembling the plurality of RFID tags into a plurality of strips and placing the plurality of strips based on the determined locations (See Francis, Col.3, lines 5-13).

As per claim 6, Francis discloses the method further comprising covering each of the plurality of strips with a protective material (See Francis, Col.9, lines 49-55; Co1.11, lines 54-67 to Co1.12, line 8).

As per claim 7, Francis discloses the method wherein placing the plurality of RFID tags comprises retrofitting a floor of the controlled area (See Francis, Col.12, lines 58-67).

As per claim 8, Francis discloses the method wherein retrofitting the floor comprises embedding each of the plurality of RFID tags in a low profile marker and installing the markers on the floor (See Francis, Col.11, lines 54-67).

As per claim 9, Francis discloses the method wherein retrofitting the floor comprises, for each of the plurality of RFID tags, making hole in the floor, inserting the RFID tag in the hole, and filling the hole (See Francis, Col.12, lines 50-67).

As per claim 10, Francis discloses the method where making a hole comprises boring a hole in the floor (See Francis, Col.11, lines 54-67).

As per claim 11, Francis discloses the method wherein the separation distance is based on the determined spacing of the plurality of RFID tags (See Francis, Col.8, lines 19-27).

As per claim 12, Francis discloses the method wherein the separation distance of the RFID interrogators is greater than the spacing determined for each of the plurality of RFID tags (See Francis, Col.3, lines 34-50; Col.9, lines 25-47).

As per claim 13, Francis discloses the method wherein the separation distance of the RFID interrogators is at least four times greater than the spacing determined for each of the plurality of RFID tags (See Francis, Col.9, lines 25-65).

As per claim 14, Francis discloses the method wherein the RFID interrogators are placed on the centerline of the vehicle (See Francis, Fig.10; Col.12, lines 1-16).

As per claim 15, Horwitz discloses a method for configuring a controlled area with RFID tags for tracking the location of items within the controlled area (See Horwitz, Co1.1, lines 13-30), and assembling the plurality of RFID tags into a plurality of strips

and placing the plurality of strips based on the determined locations (See Francis, Fig.5; Col.9, lines 11-32; Col.10, lines 16-35).

Horwitz does not explicitly disclose that the method comprising: determining a measurement accuracy for the location of the items; determining locations for a plurality of RFID tags based on the determined measurement accuracy; and placing two RFID interrogators on a vehicle used to move items within the controlled area, the RFID interrogators each configured to read the plurality of RFID tags and separated by a separation distance for determining the location of the items.

However, these features are known in the art, as evidenced by Francis. In particular, Francis suggests that method comprising: determining a measurement accuracy for the location of the items (See Francis, Col.9, lines 25-47); determining locations for a plurality of RFID tags based on the determined measurement accuracy (See Francis, Col.9, lines 32-67); placing two RFID interrogators on a vehicle used to move items within the controlled area, the RFID interrogators each configured to read the plurality of RFID tags and separated by a separation distance for determining the location of the items (See Francis, Fig.5; Col.9, lines 25-67 to Col.10, line 16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Francis within the system of Horwitz with the motivation of providing a pass-through location, such a loading dock gate or a truck docked at the loading dock gate, is marked by an RFID assembly having two RFID tags spaced in close proximity to each other (See Francis, Col.3, lines 50-64).

As per claim 20, Horwitz discloses a method for configuring a controlled area with RFID tags for tracking the location of items within the controlled area (See Horwitz, Col.1, lines 13-30).

Horwitz does not explicitly disclose that the method comprising: determining a measurement accuracy for the location of the items; determining locations for a plurality of RFID tags based on the determined measurement accuracy; and embedding each of the plurality of RFID tags in a low profile marker and installing the markers on the floor based on the determined locations; placing two RFID interrogators on a vehicle used to move items within the controlled area, the RFID interrogators each configured to read the plurality of RFID tags and separated by a separation distance for determining the location of the items.

However, these features are known in the art, as evidenced by Francis. In particular, Francis suggests that the method comprising: determining a measurement accuracy for the location of the items (See Francis, Col.9, lines 25-47); determining locations for a plurality of RFID tags based on the determined measurement accuracy (See Francis, Col.9, lines 32-67); and embedding each of the plurality of RFID tags in a low profile marker and installing the markers on the floor based on the determined locations (See Francis, Col.11, lines 54-67 to Col.12, line 26); placing two RFID interrogators on a vehicle used to move items within the controlled area, the RFID interrogators each configured to read the plurality of RFID tags and separated by a separation distance for determining the location of the items (See Francis, Fig.5; Col.9, lines 25-67 to Col.10, line 16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Francis within the system of Horwitz with the motivation of providing a pass-through location, such a loading dock gate or a truck docked at the loading dock gate, is marked by an RFID assembly having two RFID tags spaced in close proximity to each other (See Francis, Col.3, lines 50-64).

As per claim 24, Horwitz discloses a method for configuring a controlled area with RFID tags for tracking the location of items within the controlled area (See Horwitz, Col.1, lines 13-30).

Horwitz does not explicitly disclose that the method comprising: determining a measurement accuracy for the location of the items; determining locations for a plurality of RFID tags based on the determined measurement accuracy; and for each of the plurality of RFID tags, making hole in the floor in accordance with the determined locations, inserting the RFID tag in the hold, and filling the hole; placing two RFID interrogators on a vehicle used to move items within the controlled area, the RFID interrogators each configured to read the plurality of RFID tags and separated by a separation distance for determining the location of the items.

However, these features are known in the art, as evidenced by Francis. In particular, Francis suggests that the method comprising: determining a measurement accuracy for the location of the items (See Francis, Col.9, lines 25-47); determining locations for a plurality of RFID tags based on the determined measurement accuracy (See Francis, Col.9, lines 32-67); and for each of the plurality of RFID tags, making hole

in the floor in accordance with the determined locations, inserting the RFID tag in the hold, and filling the hole (See Francis, Co1.12, lines 39-67); placing two RFID interrogators on a vehicle used to move items within the controlled area, the RFID interrogators each configured to read the plurality of RFID tags and separated by a separation distance for determining the location of the items (See Francis, Fig.5; Col.9, lines 25-67 to Col.10, line 16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Francis within the system of Horwitz with the motivation of providing a pass-through location, such a loading dock gate or a truck docked at the loading dock gate, is marked by an RFID assembly having two RFID tags spaced in close proximity to each other (See Francis, Col.3, lines 50-64).

Claims 16-19, 21-23 and 25-28 recite the underlying process steps of the elements of claims 2-4, 6 and 10, and respectively. As the various elements of claims 2-4, 6 and 10 have been shown to be either disclosed by or obvious in view of the collective teachings of Horwitz and Francis, it is readily apparent that method claims disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 16-19, 21-23 and 25-28 are rejected for the same reasons given above for claims 2-4, 6 and 25-28, and incorporated herein.

Response to Arguments

6. Applicant's arguments filed on 10/17/08 with respect to claims 1-28 have been fully considered but they are not persuasive.

(A) At pages 1-6 of the response filed on 10/17/08, Applicant's argues the followings:

(i) Horwitz in view of Francis fails to make out a prima facie of obviousness.

(ii) Francis does not teach using multiple interrogators in combination to read the RFID tags in order to determine an item's location.

(B) With respect to Applicant's first argument, the Examiner respectfully submitted that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention.

Rather, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a

patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

(i) obviousness does not require absolute predictability;
(ii) non-preferred embodiments of prior art must also be considered; and
(iii) the question is not express teaching of references, but what they would suggest.

(C) With respect to Applicant's second argument, the Examiner respectfully submitted that He relied upon the teaching of Francis (See Fig.5; Col.9, lines 25-67 to Col.10, line 16) which correspond to Applicant's claimed feature. Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vanel Frenel/

Examiner, Art Unit 3687

December 26, 2008

/Matthew S Gart/

Supervisory Patent Examiner, Art Unit 3687